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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,135	07/13/2004	Fabio Gianniessi	725.1050	7877
20311 7590 11/24/2009 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER YOUNG, SHAWQUITA				
ART UNIT		PAPER NUMBER		
1626				
NOTIFICATION DATE		DELIVERY MODE		
11/24/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

### Office Action Summary

**Application No.**

10/501,135

**Applicant(s)**

GIANNESI ET AL.

**Examiner**

SHAWQUA YOUNG

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,7,9,10 and 12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 5 is/are allowed.  
6) ☒ Claim(s) 1,3,7,9,10 and 12 is/are rejected.  
7) ☒ Claim(s) 4 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 3/30/09 and 8/21/09  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1, 3-5, 7, 9, 10, and 12 are currently pending in the instant application. Applicants have amended claims 1, 3 and 12 in an amendment filed on July 7, 2009. Claims 1, 3, 7, 9, 10 and 12 are rejected, claim 4 is objected and claim 5 is allowed in this Office Action.

#### **I. *Response to Arguments/Remarks***

Applicants' amendment, filed on July 7, 2009 has overcome the rejection of claim 12 under 35 USC 102(b) as being anticipated by Crandall, et al.; the rejection of claim 12 under 35 USC 102(e) as being anticipated by Brooks, et al. (US 7,192,982) and the rejection of claim 3 under 35 USC 112, second paragraph as lacking antecedent basis. The above rejections have been withdrawn.

Applicants' amendment has failed to overcome the rejection of claims 1,3,7,9 and 10 under 35 USC 102(e) as being anticipated by Brooks, et al. (US 7,192,982) because the prior art reference still teaches compounds which anticipate the instantly claimed compounds (i.e, see example 322 on column 320). Therefore, the rejection has been maintained.

#### **II. *Information Disclosure Statement***

The information disclosure statements (IDS) submitted on March 30, 2009 and August 21, 2009 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

### III. *Rejection(s)*

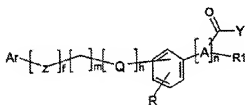
#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3, 7, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by *Brooks, et al.* (US 7,192,982). The instant invention claims a product with the formula



wherein **A** is CH, alkanylidene with 2 to 4 carbon atoms or alkenylidene with 2 to 4 carbon atoms; **Ar** is phenyl optionally substituted by halogens, NO<sub>2</sub>, OH, C<sub>1-4</sub> alkyl and alkoxy, said alkyl and alkoxy optionally substituted by at least one halogen; **f** is the number 0 or 1; **h** is the number 0 or 1; **m** is a whole number from 0 to 3; **n** is the number 0 or 1 and if **n** is 0, **R<sub>1</sub>** is absent and COY is directly bound to benzene; **Q** is oxygen; **Z** is as defined in claim 12; **R** is selected from **R<sub>2</sub>** and **OR<sub>2</sub>**; **R<sub>1</sub>** is as defined in claim 12; and all other variables are as defined in claim 12.

The *Brooks, et al.* reference teaches modulators of PPARs such as (2S)-3-{4-[2-

(3-fluoro-phenoxy)-ethoxy]-phenyl]-2-methoxy-propionic acid (See ex. 322, column 320). This species of compound anticipates the genus compound of the instant invention, wherein the genus structure and its definitions are stated above.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "R<sub>1</sub> is selected from H, COW, SO<sub>3</sub><sup>-</sup>, OR<sub>3</sub>, =O, CH and NH<sub>2</sub> ; Y is selected from OH, OR<sub>5</sub> and NH<sub>2</sub> and that A, COY



and R<sub>1</sub> together form a cycle of the type: . However it is impossible for R<sub>1</sub> to be selected from H, COW, OR<sub>3</sub>, R=O, CH and NH<sub>2</sub> and Y to be OH and OR<sub>3</sub> when



the end of the claim says that A, COY and R<sub>1</sub> together from the ring .  
Appropriate correction is suggested.

### **IV. Objections**

*Dependent Claim Objections*

Dependent Claim 4 is also objected to as being dependent upon a rejected based claim.

**V. Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626